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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/543,125	04/05/2000	Brett T. Hannigan	60154	7024

23735 7590 01/30/2002

DIGIMARC CORPORATION
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EXAMINER

HESS, DANIEL A

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 01/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/543,125

Applicant(s)

HANNIGAN, BRETT T.

Examiner

Daniel A Hess

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: The term Internet is used in a number of occasions. Wherever this term is used, it must be capitalized.
2. Appropriate correction is required.

Claim Objections

3. Claims 3, 7, 10, 11, and 12 are objected to because minor informalities, which can be corrected as follows: In claim 2, line 1 replace 'the software instructions' with --said software instructions--. In claim 7, line 2, replace 'the scan data' with --said scan data--. In claims 10 and 11, line 1 replace 'the identifier' with --said identifier--. In claim 12, lines 2 and 3, replace 'the scanner' with --said scanner--. In lines 2, 3 and 4 capitalize 'internet.'
4. Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:
 6. A person shall be entitled to a patent unless –
 7. the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
8. Claim 12 rejected under 35 U.S.C. 102(a) as being anticipated by Tracy(US 5,979,757).
9. Tracy shows (see figure 2) a barcode scanner (linear sensor array), a screen, and user controls. There is (see figure 3) an interface means; this interface is connected with the Internet as is evident from the fact that the system gathers and displays web pages (col. 2, line 45). The

Art Unit: 2876

device as a whole operates by transmitting scanned data across network and getting HTML data back. It must have a CPU to perform these functions.

Claim Rejections - 35 USC § 103

10. Claims 1, 2 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art disclosed by the applicant in view of Tracy.

11. Re claims 1 and 11:

12. The prior art disclosed by the applicant includes all that which is improved upon in claim 1.

13. The prior art does not show discerning a machine-readable identifier.

14. Tracy shows (figure 2) a barcode scanner, on which enabling software must be loaded.

15. In view of the teaching of Tracy, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the old and well-known idea of scanning barcodes into the 2D sensor arrays of the prior art because many items are encoded with barcodes, and valuable data about these items can be gathered.

16. Re claim 2:

17. Tracy shows a wireless interface, a display and software causing the scanner to use wireless to get an ID to a remote server and process information returned for presentation on this display col 2, lines 12-56).

18. In view of Tracy, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the old and well-known remotely-linked scanning system of

Art Unit: 2876

taught by Tracy into the prior art because users often desire more information about products that is immediately available.

19. Claims 3-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art disclosed by the applicant as modified by Tracy applied to claim 1 above in further view of Cherry (US 6,142,376) and Wang (5,790,703). The teachings of the applicant disclosed in discussion of prior art as modified by Tracy has been discussed above.

20. Re claims 3, 4, and 5:

21. The teachings of the applicant disclosed in discussion of prior art as modified by Tracy fail to show a watermark detection process in addition to reading the watermark.

22. Cherry shows (see figure 4) the dual process of locating a barcode on an item and further reading the barcode on that item. A discussion of this process is made in cols. 10 and 11. Cherry further notes (col 11, line 30) that only 8% of the area is scanned, indicating focus on portions of scan area most likely to be fruitful.

23. Wang teaches watermarks that are hidden in images (abstract).

24. Given the teachings of Cherry it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the old and well-known idea of first locating a marking and then actually reading the marking, in order not to waste time trying to read an area that has no meaningful encoded data. In view of Wang, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the old and well-known idea of watermarking because watermarks have the same uses as barcodes and in addition are not so visually obtrusive.

25. Re claims 7, 8 and 9:

Art Unit: 2876

26. The teachings of the applicant disclosed in discussion of prior art as modified by Tracy fails to show a detection process involving variation in the scanned surface.

27. Cherry (figures 9, 10, and 11) shows a variety of orientations and configurations of the scanned surface, including different relative distances in different scanned portions. Further, as 12C shows, the surface can have various characteristics, in that case curvature. This is achieved through software.

28. In view of the teaching of Cherry, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the old and well-known versatility in scanning through software in the teachings of the applicant disclosed in discussion of prior art as modified by Tracy because it increases the likelihood of successful scanning.

Conclusion

29. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Wilz, SR et al.(US 6,338,434) discusses a system of accessing information from the Internet by scanning bar codes on objects, much like Tracy.

30. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel A Hess whose telephone number is (703) 305-3841. The examiner can normally be reached on 8:00 AM - 5:00 PM M-F.


31. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G Lee can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Art Unit: 2876

32. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

33. DH

34. January 28, 2002



KARL D. FRECH
PRIMARY EXAMINER